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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,608	08/04/2003	Peng Zhang	06292P USA	6594

23543 7590 10/20/2004

AIR PRODUCTS AND CHEMICALS, INC.
PATENT DEPARTMENT
7201 HAMILTON BOULEVARD
ALLENTOWN, PA 181951501

EXAMINER

SCHILLING, RICHARD L

ART UNIT PAPER NUMBER

1752

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,608

Applicant(s)

ZHANG ET AL.

Examiner

Richard L Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. The requirement for restriction is repeated and made FINAL. The search for the process claims does not include searches for the composition claims used in different processes.

2. Claims 19-28 are rejected under 35 U.S.C. § 102(e) as being fully met by Skee for the same reasons as set forth in item No. 2 of the first Office action filed May 26, 2004.

3. Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being fully met by European Patent Publication 1115035 for the same reasons as set forth in paragraph 3 of the first Office action.

4. Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being fully met by Tanaka et al. or Matsuda et al. for the same reasons as set forth in paragraph 4 of the first Office action.

5. Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being fully met by Honda for the same reasons as set forth in paragraph 5 of the first Office action.

6. Claims 19-28 are rejected under 35 U.S.C. § 102(b) as being fully met by Nishi et al. '854 for the same reasons as set forth in paragraph 6 of the first Office action.

7. Claims 19-28 are rejected under 35 U.S.C. § 102(e) as being fully met by Lassila et al. '182 for the same reasons as set forth in paragraph 7 of the first Office action.

8. Applicant's arguments filed August 30, 2004 have been

fully considered but they are not deemed to be persuasive. Applicant's argument that the instant claims now specifically exclude compounds that are found in the applied prior art is unconvincing since the instant claims only require the claimed compositions to be free of one of the listed compounds and not all of the listed compounds. Each of the applied references is free of at least one of the listed compounds the instant claims are required to be free of. Also, European Patent Publication 1115053 and Lassila et al. '182 disclose various compositions containing the surfactants of the instant claims without any of the excluded compounds, e.g. in inks and fountain solutions and in Examples 26 and 33-53. Examples 26 and 33-53 of the European patent publication and Lassila et al. contain only the surfactants and water.

9. Claims 19-28 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to comply with the written description requirement. The specification fails to contain a written description of compositions set forth in the instant claims free of one or more compounds as listed in the instant claims. The specification does not generically exclude the compounds listed or disclose the compounds listed as optional ingredients.

10. Claims 19-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claimed compositions is indefinite as to what is included and excluded. The compositions exclude macromolecular compounds which are not defined in the specification or claims by molecular weight. The claims also exclude oligomers which are defined in the specification (page 12, lines 7-10) as compounds with a few monomer units. However, the required compounds of Formulas I and II of the instant claims have repeating units and could be considered oligomers or macromolecules. The dispersants required by instant claims 21 and 22 include polymer resins and oligomers which are also excluded from the claims. Claims 21 and 22 depend on cancelled claim 20.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION

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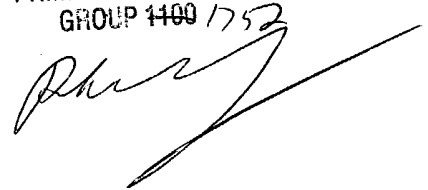
IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

12. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

October 18, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1400 1752

A handwritten signature in black ink, appearing to read 'R. Schilling', is written over the typed name and title.